

Applicant: Stoltze et al.
Application Serial No.: 10/020,592
Filing Date: December 12, 2001
Docket No.: 760-46 CIP/PCT/USA/CON2
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REMARKS

The requirement for restriction issued by the Examiner is believed to be in error and for the reasons set forth hereinbelow withdrawal of the restriction requirement is respectfully requested.

The Examiner has determined that inventions I and II are related as a process and a product made by the process. The Examiner contends that pursuant to MPEP §806.05(f) restriction is warranted. While MPEP §806.05(f) is applicable, restriction by the Examiner does not appear to be mandatory.

In the present case, restriction in the manner proposed by the Examiner would place an undue hardship on applicants moreover, maintaining the claims in a single application for prosecution would not place an undue burden on the Examiner.

The present application is a continuation of Application Serial No. 08/591,506, filed on August 19, 1996 (the "056" application). In related Application Serial No. 09/711,034 filed November 13, 2000 (the "034" application) which itself is a continuation of the '056 application, claims to both a method of producing a catheter system as well as product claims to a catheter system were searched and examined together and found to be allowable. The '034 application was allowed in a Notice of Allowance mailed September 30, 2002. The issue fee was paid on

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December 19, 2003. Thus, notwithstanding the presence of both method and apparatus claims, the Examiner was able to conduct the appropriate search, examine and allow the claims in a single application.

The '034 application was withdrawn from issuance in a petition filed on February 27, 2003 in favor of the filing a further continuation application in order to allow the PTO to consider additional references cited by applicants in a Supplemental Information Disclosure Statement. The references cited in the Supplemental Information Disclosure Statement in the '034 application, which are cited in the present continuation application, include U.S. Patent No. 5,836,965, 6,159,229 and 6,309,402 each issued to Jendersee, et al.

Specifically, with respect to the '402 Jendersee, et al. patent, claims have issued therein which are directed both to a method of attaching a stent to a balloon and a catheter stent delivery system. Again, the PTO has determined that these inventions were properly searched and examined together without need for restriction. Accordingly, since the PTO has previously determined that a method of attaching a stent to a balloon, as well as a catheter stent system can be searched and examined together as evidenced by the issuance of the '402 patent and more importantly, as the PTO has, in fact, examined this combination of claims with respect to the '034 application which is related to the present application, it is respectfully submitted that no

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undue burden would be placed on the Examiner to maintain the claims in question in the present application without restriction.

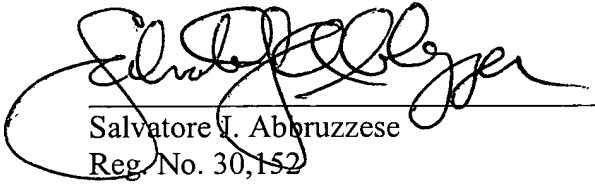
Furthermore, applicants will suffer substantial hardship if the restriction requirement is maintained. As the Examiner knows, it is contemplated that an interference is possible between the claims of the present application and at least the '402 Jendersee patent. If applicants were required to restrict the claims of the present application as requested by the Examiner, applicants would be a distinct disadvantage in any interference proceeding against the '402 patent inasmuch as the '402 patent includes claims directed to both the method and apparatus.

As such, since it has been established that the method of attaching a stent to a balloon as well as a catheter stent system can be searched and examined together and, in fact has been, there is no undue burden on the PTO to withdraw the requirement of restriction and maintain the present claims in a single application. Moreover, as it has been established that applicants would be placed at a significant disadvantage in an interference proceeding if the restriction was maintained, withdrawal of the restriction requirement is warranted.

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Should the Examiner have any questions regarding this response or wish to discuss this matter in further detail, please contact the undersigned attorney at the telephone number set forth below.

Respectfully submitted,



Salvatore J. Abbruzzese
Reg. No. 30,152
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700